

REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Claim Rejections Under 35 USC 103

Claims 1, 3 – 12, 13 – 30, and 32 are rejected under 35 USC 103(a) as being unpatentable over Lawande et al., U.S. Patent No. 6,219,697 (hereinafter referred to as “Lawande”).

To establish a *prima facie* case of obviousness, certain criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. (MPEP 2143).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

NO REASONABLE EXPECTATION OF MODIFYING

Applicants respectfully submit that it would not have been obvious to modify to Lawande to include the guaranteed unique identifier (GUID) as a virtual address because

there would have been no reasonable expectation of successfully modifying Lawande at the time Lawande was invented. (See Manual of Patent Examining Procedure ¶ 2143.02; See also *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

In particular, GUID is not a protocol, but rather is claimed as an address. Therefore, there would be no reasonable expectation of successfully modifying the protocol disclosed Lawande with the claimed virtual address of GUID because GUID is not a protocol and therefore could not provide the functionality of the protocol disclosed in Lawande.

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In the present matter, Lawande is not capable of being modified to use the claimed virtual address of GUID as a protocol, and as such, there is clearly not suggestion or motivation in Lawande to do so.

In addition, a statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time claimed invention was made’ “ because the references relied upon teach that all aspect of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

In the present matter, there is no objective reason to combine or modify the teachings of Lawande, because Lawande is not capable of being modified to use the claimed virtual address of GUID as a protocol.

Conclusion

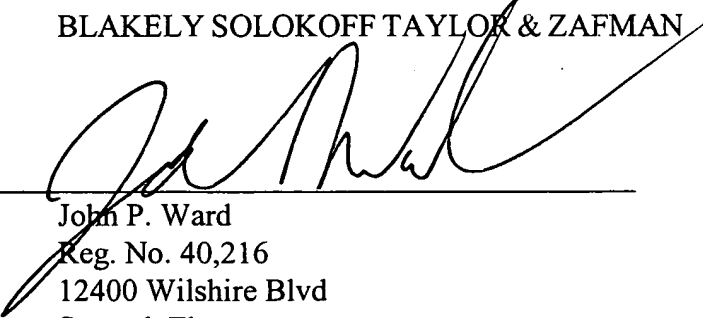
For the foregoing reasons, Applicant submits that the application is now in condition for allowance, and indication of allowance by the Examiner is respectfully requested. If the Examiner has any questions concerning this application, he or she is requested to telephone the undersigned at the telephone number shown below as soon as possible. If any fee deficiency or overpayment is detected, please charge any insufficiency or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,

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